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| 09/998,116 | 11/30/2001 | Mitsuru Goto | 7217/66046 | 4446 |

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EXAMINER

DOAN, DUYEN MY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2143

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,116

Applicant(s)

GOTO, MITSURU

Examiner

Duyen M. Doan

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detail Action

Claims 1-10 are amended for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al (us pat 6731630) (hereinafter Schuster) in view of Waites (us pat 6788769).

As regarding claim 1, Schuster discloses plurality of communication devices for inputting telephone number and an identification number of the destination telecommunication services operator (col.15, lines 58-67, plurality of communication devices in figure 1); a storage device for storing a reference table in which the input identification number of the destination telecommunication services operator is correlated with the domain name of the destination telecommunication services operator (col.14, lines 44-56, col.15, lines 58-67, col.18, lines 9-24); a communication management device for using the input identification number of the destination telecommunication services operator as an address for reading the domain name of the destination telecommunication services operator from the reference table, the input

Art Unit: 2143

telephone with the domain name read from the storage device (col.14, lines 44-55, col.8, lines 9-24).

Schuster does not expressly disclose communicating to the destination the electronic mail information using the electronic mail address, form the electronic mail address for sending the electronic mail information.

Waites teaches the inputted telephone number and an identification number of the destination telecommunication services operator for communicating to the destination the electronic mail information using the electronic mail address, form the electronic mail address for sending the electronic mail information (col.5, lines 66-67, col.6, lines 1-5).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate teaching of Waites to the system of Schuster to use the telephone and identifier of Schuster as the email address in Waite system, because by communicating to the destination the electronic mail information using the electronic mail address, form the electronic mail address for sending the electronic mail information would simplified addressing for Internet and telephone messaging (see Waites col.1, lines 39-41)

As regarding claim 2, Schuster-Waites disclosed the reference table is automatically updated with a new domain name of the telecommunication services operator at a desired time (see Schuster, Fig.6, update the database to include unique communication number (domain portion and subscriber portion)).

As regarding claim 3, Schuster-Waites disclosed communication management device of the telecommunication services operator is connected to a communication management device of another telecommunication services operator through a communication network, and transmits said electronic mail information to said communication device which is line-connected to the other telecommunication services operator (col.18, line s9-24, col.16, lines 63-65, 1st connection server, second connection server, DNS).

As regarding claim 4, Schuster-Waites disclosed Waites disclosed country information, in addition to said identification number is correlated with the domain name in the reference table stored in said storage device (see Waites col.6, lines 1-5, lines 18-32). The same motivation was utilized in claim 1 applied equally well to claim 4.

As regarding claim 5, the claim limitations are similar to claim 1, therefore rejected for the same rational as claim 1.

As regarding claim 6, the claim limitations are similar to claim 2, therefore rejected for the same rational as claim 2.

As regarding claim 7, the claim limitations are similar to claim 3, therefore rejected for the same rational as claim 3.

As regarding claim 8, the claim limitations are similar to claim 1, therefore rejected for the same rationale as claim 1.

As regarding claim 9, the claim limitations are similar to claim 2, therefore rejected for the same rational as claim 2.

As regarding claim 10, the claim limitations are similar to claim 4, therefore rejected for the same rational as claim 4.

Response to Arguments

Applicant's arguments filed 10/28/05 have been fully considered but they are not persuasive.

As regarding applicant argument "In Schuster the first part of the input identification number is not a telephone number and in Waite, the second part of the email address is not a domain name of the destination telecommunication services operator". Examiner disagrees, the first part and the second part are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 merely disclose inputting the telephone number and the identification number, the telephone number and the identification number is clearly disclose by Schuster (see Schuster col.15, lines 58-67, col.16, lines 51-67). "699-0360" is the telephone number and "202" is the domain identification number.

As regard to applicant argument, "the primary reference Schuster fails to provide motivation to combine itself with Waits, the rejection of independent claim 1 is improper". The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

Art Unit: 2143

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Schuster suggests that using user and device identifier that are in form similar to an email address (see Schuster col.14, lines 44-47).

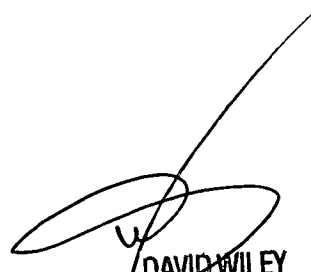
Art Unit: 2143

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M. Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Duyen Doan
Art unit 2143



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100